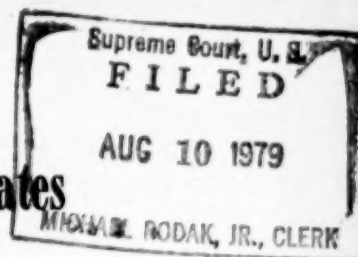


IN THE
Supreme Court of the United States



October Term, 1979
No. 79-50

SATCO, INC.,

Petitioner,

vs.

TRANSEQUIP, INC.,

Respondent.

SATCO, INC.,

Petitioner,

vs.

SEABOARD WORLD AIRLINES,

Respondent.

**Opposition to Petition for Writ of Certiorari to the
United States Court of Appeals for the Ninth
Circuit.**

ROBERT D. HORNBAKER,
A Member of
FREILICH, HORNBAKER, WASSERMAN,
ROSEN AND FERNANDEZ,
A Professional Corporation,
10960 Wilshire Boulevard, Suite 1432,
Los Angeles, Calif. 90024,
(213) 477-4039,

Attorneys for Respondents.

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TRANSEQUIP, INC.,		<i>Respondent.</i>
SATCO, INC.,	vs.	<i>Petitioner,</i>
SEABOARD WORLD AIRLINES,		<i>Respondent.</i>

**Opposition to Petition for Writ of Certiorari to the
United States Court of Appeals for the Ninth
Circuit.**

I.

Statement of the Case.

A. The Patent in Suit.

Looker U.S. Patent No. 3,698,677, entitled "Pallet for Moving and Securing Cargo," filed January 22, 1970, issued October 17, 1972, PX-1,* covers an aircraft pallet having a metal frame around a single sheet, or plate, of metal, usually aluminum. These pallets are about 88 inches wide, and either 108

*Plaintiff's Exhibit 1.

or 125 inches long. The description states the thickness of an aluminum sheet, for example, should be "in the range of 0.150 inch-0.375 inch," at col. 6, lines 8-9.

Looker called his patent a "picture frame," R.Tr. 554:21-555:12,* and the pallet a "cookie sheet." R.Tr. 555:13-14.

B. The District Court Opinion.

In holding the patent invalid, under Section 103 of Title 35, United States Code, the District Court said, in a Memorandum of Decision, attached as Appendix B to the Petition, at pages 13-14:

Each basic element combined in the Looker pallet—center panel, frame, rivets, sockets—was known in the prior art. The pivotal question under §103 is, then, whether this assemblage of old elements created a valid combination patent by producing a result that can be characterized as synergistic, *i.e.*, "result[ing] in an effect greater than the sum of the several effects taken separately." *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 61, 90 S.Ct. 305, 308, 24 L.Ed.2d 258 (1969).

Satco argues that the Looker combination patent does indeed produce a synergistic result. The synergism of Looker's invention, according to Satco, is a novel interaction between the thicker aluminum frame and the thinner aluminum center panel, producing a combined structure that is both rigid and flexible. Rigid when the pallet is subjected to substantial horizontal forces; flexible when sub-

*Reporter's Transcript, page 554, line 21 to page 555, line 12.

jected to vertical forces. But the sum of such effects is exactly what one would expect from the elements of this structure. An ordinary aluminum cafeteria tray will produce the same expected effects.¹ Looker's combination does not produce a synergism—it only produces expected results. See *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 96 S.Ct. 1532, 47 L.Ed.2d 784, 44 U.S.L.W. 4477, 4480 (1976).

In short, while Looker's combination of known elements performs a useful function and enjoys moderate commercial success, it produces no synergistic results, *i.e.*, it "is wanting in any unusual or surprising consequences"; therefore, it is not patentable under the test applicable to combination patents. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 512, 71 S.Ct. 127, 130, 95 L.Ed. 162 (1950). "The [*A&P Tea*] 'unusual or surprising consequences' test for patentability of combination devices . . . is now codified [by the 1952 Patent Act] in 35 U.S.C. §103, which denies patentability if the differences between the subject of the patent

¹Indeed, substantially the same results were produced by Currie's prior art unpatented all-aluminum pallet, which, in fact, was a large tray. The Currie pallet was designed in 1964 by Robert Currie, a civilian engineer at Norton Air Force Base, to eliminate problems of warping, tearing, and delamination suffered by the Air Force's laminated balsa-aluminum pallets. Using Currie's design, the Air Force built two all metal pallets out of ¼" aluminum plate. The borders of the aluminum sheet were turned up at an angle of about 30° and the four corners were then welded to form a large tray, 54" wide, 88" long, and 1-3/16" deep. The turned up borders were provided with slots for cargo net hooks. After undergoing ground experiments, one of Currie's pallets was used publicly in 1965 to transport military air cargo. The Air Force, however, declined to use Currie's innovation and continues to use its earlier developed pallet.

and the prior art would have been obvious to a person having ordinary skill in the art." *Deere & Co. v. Sperry Rand Corp.*, 513 F.2d 1131, 1132 (9th Cir. 1975).

Accordingly, the court concludes that the subject matter of the Looker combination patent was obvious within the meaning of 35 U.S.C. §103. U.S. Patent No. 3,698,677 is therefore declared invalid.

So, as appears above, the District Court made these findings and conclusions:

- (1) "Each basic element combined in the Looker pallet—center panel, frame, rivets, sockets—was known in the prior art."
- (2) "Looker's combination . . . 'is wanting in any unusual or surprising consequences.'"
- (3) "Looker's combination . . . produces expected results."
- (4) ". . . the sum of such effects is exactly what one would expect from the elements of this structure."
- (5) ". . . , substantially the same results were produced by Currie's prior art unpatented all-aluminum pallet . . ."
- (6) ". . . the subject matter of the Looker combination patent was obvious within the meaning of 35 U.S.C. §103."

Also, as appears above, the District Court equated lack of synergistic results with wanting in any unusual or surprising consequences. Said the Court, at page 14:

. . . Looker's combination . . . produces no synergistic results, *i.e.*, it "is wanting in any unusual or surprising consequences"; therefore it is

not patentable under the test applicable to combination patents. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 71 S.Ct. 127, 130, 95 L.Ed. 163 (1950).

According to *Webster's Third New International Dictionary* (1968), at pages 1124 and 2367, "*i.e.*," means "that is," which, in turn, means "the following or immediately preceding word or word group may express the intended meaning more understandably or more accurately than a previous word or word group—used to introduce or accompany an explanation or correction."

C. Opinion of the Court of Appeals.

Respondent Transequip argued, in its Brief, and at the oral hearing, that the District Court properly applied the Section 103 test, as explained in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459 (1966). Transequip also argued that the District Court was right in considering the lack of a synergistic result, and equating it with wanting in any unusual or surprising consequences.

The Court of Appeals agreed.

Said the Court, including former Chief Judge Chambers, in its opinion, attached as Appendix A to the Petition, at pages 5-7:

Satco asserts that the district court, in the portions of its opinion quoted above, utilized an inappropriate test of nonobviousness, equating nonobviousness with producing a synergistic result (or "unusual or surprising consequences"), rather than undertaking the factual analysis required by the *Graham* case, *supra*. Accordingly, Satco contends that we must vacate the judgment and

remand the case to the district court for a redetermination of the obviousness issue under the analysis set forth in *Graham*.

We reject this contention. The district court did not precisely articulate its application of the *Graham* analysis in deciding the obviousness issue. However, a reading of the court's entire opinion, in the context of the extensive record in this case, reveals that the district court in fact appropriately examined the prior art in comparison with the Looker patent and took into account the level of ordinary skill in the pertinent art.

The district court's careful description of the differences between the Looker patent and prior art pallets, *Satco, supra*, 415 F.Supp. at 224, reflects the comprehensive evidence in the record regarding "the scope and content of the prior art" and the "differences between the prior art and the claims at issue," the first two factual inquiries required by *Graham, supra*. The record amply supports the district court's findings that, although Looker improved upon prior art pallets, each basic component of the Looker patent was known in the prior art.

We think it is also clear, from the district court's reference to a prior art unpatented pallet achieving effects similar to those of the Looker patent, that the court took into account the third *Graham* consideration, the level of ordinary skill in the pertinent art, in finding that the Looker pallet produces only "expected effects." *Satco, supra*, 415 F.Supp. at 224 and n.1. Moreover, the court's quotation of the "obvious to a person having ordinary skill in the art" language of *Deere & Co. v. Sperry Rand Corp.* 513 F.2d 1131, 1132

(9th Cir. 1975), and its reference to "the meaning of 35 U.S.C. §103," *id.* at 225, which statute contains similar language, indicates the court's awareness of the importance of the level of ordinary skill in assessing obviousness.

We therefore conclude that the district court made the factual inquiries required by *Graham* and section 103 as a background to its assessment of obviousness.

After addressing the factual inquiries called for by the *Graham* case, the district court was called upon to form a legal conclusion as to the section 103 condition of patentability.³ In forming its legal conclusion that the Looker device failed of patentability for obviousness, the district court properly considered the failure of that device, which combines old elements, to create a synergistic result⁴ or to disclose any "unusual or surprising consequences." See *Sakraida v. Ag Pro*, 425 U.S. 273, 282 (1976); *Anderson's-Black Rock v. Pavement Salvage Co.*, 396 U.S. 57, 60-61 (1969); *Penn International Industries v. Pennington Corporation*, 583 F.2d 1078, 1081 (9th Cir. 1978); *Reinke Manufacturing Co. v. Sidney Manufacturing Co.*, Nos. 78-1341, 78-1301, slip op. at 8 (8th Cir. Feb. 26, 1979).

³While the *Graham* case indicates that resolution of the obviousness issue under §103 necessarily entails certain factual inquiries, the ultimate test of patent validity remains one of law. See *Sakraida v. Ag Pro*, 425 U.S. 273, 280 (1976).

⁴A synergistic result occurs when a combination of elements produces an effect greater than the sum of the several effects of the elements taken separately. See *Anderson's-Black Rock v. Pavement Salvage Co.*, 396 U.S. 57, 61 (1969).

Ample evidence in the record supports the district court's determination that the Looker patent is invalid as obvious within the meaning of 35 U.S.C. §103, and we affirm on that issue.

So the District Court did not invalidate Looker's patent, "without even a reference to *Graham*," as stated on page 3 of the Petition.

Also, neither the District Court, nor the Court of Appeals, held that "a nonstatutory, post-invention, factual determination—labeled 'synergism'— is the ultimate constitutional test of patentability for a combination of elements," as stated on page 2 of the Petition.

And, the Court of Appeals did not add to the *Graham* analysis "a fourth factual inquiry determinable only after an invention has been made, the existence of which, . . . is the essential legal criteria of patentability," as stated on page 4 of the Petition.

Instead, the District Court, and the Court of Appeals, applied the Section 103 test, as explained in *Graham*, and properly considered the failure of the old combination to provide any unusual or surprising consequences, as required by the *A.&P.* case, and codified in Section 103. *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 466 (1966).

Incidentally, the experienced District Court had previously held five patents valid, and five patents invalid. The Court of Appeals had affirmed all 10. *Stukenborg v. Teledyne*, 299 F.Supp. 1152, 161 USPQ 10 (C.D. Calif. 1969), *aff'd.*, 441 F.2d 1069, 169 USPQ 584 (9th Cir. 1971); *Volvo v. Cummings & Sander*, 161 USPQ 198 (C.D. Calif. 1969), *aff'd.*,

435 F.2d 981, 168 USPQ 332 (9th Cir. 1970); *Reeves v. Beckman*, 161 USPQ 450 (C.D. Calif. 1968), *aff'd.*, 444 F.2d 263, 170 USPQ 74 (9th Cir. 1971), *cert. denied*, 404 U.S. 951, 171 USPQ 641 (1971); *Bates v. Daytona*, 310 F.Supp. 311, 163 USPQ 385 (C.D. Calif. 1969), *aff'd.*, 441 F.2d 1110, 169 USPQ 778 (9th Cir. 1971); *Edoco v. Peter Kiewit*, 313 F.Supp. 1081, 165 USPQ 207 (C.D. Calif. 1970), *aff'd.*, 411 F.2d 988, 177 USPQ 418 (9th Cir. 1973); *Union Carbide v. Filtrol*, 170 USPQ 482 (C.D. Calif. 1971), *aff'd.*, 179 USPQ 209 (9th Cir. 1973).

So the following statement in 5A *Moore's Federal Practice*, ¶52.03[1], at page 2627, was particularly apt:

. . . another factor is the reliability of the trier of the facts . . ., the reputation and standing of the trial judge for experience, discernment, detachment, reliability, carefulness, probity and other qualities that combine to make judging the master's art cannot and should not be ignored.

In this connection, President Carter recently nominated the District Court judge for a vacancy on the Court of Appeals.

II.

Argument.

A. The District Court, and the Court of Appeals, Properly Equated Lack of Synergistic Results With Wanting in Any Unusual or Surprising Consequences.

Prior to the enactment of Section 103, in 1952, the courts had developed a negative rule applicable to bringing old elements together. In *Great A.&P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S.

147, 87 USPQ 303 (1950), Mr. Justice Jackson stated the rule in these three italicized ways, at pages 150-153:

What indicia of invention should the courts seek in a case where nothing tangible is new, and invention, if it exists at all, is only in bringing old elements together?

While this Court has sustained combination patents, it never has ventured to give a precise and comprehensive definition of the test to be applied in such cases. The voluminous literature which the subject has excited discloses no such test. It is agreed that the key to patentability of a mechanical device that brings old factors into co-operation is presence or lack of invention. In course of time the profession came to employ the term "combination" to imply its presence and the term "aggregation" to signify its absence, thus making antonyms in legal art of words which in ordinary speech are more nearly synonyms. However useful as words of art to denote in short form that an assembly of units has failed or has met the examination for invention, their employment as tests to determine invention results in nothing but confusion. The concept of invention is inherently elusive when applied to combination of old elements. This, together with the imprecision of our language, have counselled courts and text writers to be cautious in affirmative definitions or rules on the subject.

The negative rule accrued from many litigations was condensed about as precisely as the subject permits in *Lincoln Engineering Co. v. Stewart-*

Warner Corp., 303 U.S. 545, 549: "*The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention.*" To the same end is *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U.S. 350, and *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84. The conjunction or concert of known elements must contribute something: *only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable.* Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics. *This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned*, and there is nothing to indicate that the lower courts scrutinized the claims in the light of this rather severe test." (Italics added.)

Since the enactment of Section 103, the Supreme Court has continued to cite the *A.&P.* case, and apply this negative rule to bringing old elements together. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 61, 163 USPQ 673, 674 (1969); *Sakraida v. Ag Pro*, 425 U.S. 273, 280-283, 189 USPQ 449, 452-453 (1976); *Roanwell v. Plantronics*, 429 U.S. 1004, 192 USPQ 65 (1976).

In *Anderson's-Black Rock*, Justice Douglas, the man who coined the controversial phrase, "flash of creative

genius,”* in *Cuno v. Automatic Devices*, 314 U.S. 84, 51 USPQ 272 (1941), used the words “synergistic result,” for the first time.

Said he, at pages 60-61:

The combination of putting the burner together with the other elements in one machine, though perhaps a matter of great convenience, did not produce a “new or different function,” *Lincoln Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549, 37 USPQ 1, 3, within the test of validity of combination patents.

A combination of elements may result in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here. (Italics added.)

So, in describing the lack of synergistic result, Douglas used two of the ways set forth in *A.&P.* of stating the negative rule.

First, he used the words “new or different function,” quoted from *Lincoln Engineering*, in *A.&P.*

Second, in talking about “an effect greater than the sum of the several effects,” he paraphrased these words, in *A.&P.*, at page 152:

... only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable.

In *Sakraida v. Ag Pro*, 425 U.S. 273, 189 USPQ 449 (1976), the Court also considered the lack of

*In *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), the court said, at page 15, in footnote 7: “. . . the reference to ‘flash of creative genius’ was but a rhetorical embellishment of language going back to 1833.”

synergistic result to be the same as the negative rule in *A.&P.*, as stated in *Anderson's-Black Rock*.

Said the Court, at page 282:

We cannot agree that the combination of these old elements to produce an abrupt release of water directly on the barn floor from storage tanks or pools can properly be characterized as synergistic, that is, “*result[ing] in an effect greater than the sum of the several effects taken separately.*” *Anderson's-Black Rock v. Pavement Co.*, 396 U.S. 57, 61, 163 USPQ 673, 674 (1960). (Italics added.)

The negative rule was also stated a third way, in *A.&P.*, that is, bringing old elements together is not patentable invention if the unification is wanting in any “unusual or surprising consequences”.

So the District Court, and the Court of Appeals, followed this Court in considering lack of synergistic result as a rhetorical embellishment on the negative rule set forth in *A.&P.*, and one way of stating that rule is: bringing old elements together is not patentable invention if the unification is wanting in any “unusual or surprising consequences.” *Accord: American Seating v. National Seating*, 586 F.2d 611, 621, 199 USPQ 257, 264 (6th Cir. 1978); *Kearney & Trecker v. Cincinnati Milacron*, 562 F.2d 365, 370, 195 USPQ 402, 405-406 (6th Cir. 1977); *Saginaw Products v. Eastern Airlines*, 195 USPQ 551, 560 (E.D. Mich. 1977); *In re Freeman*, 573 F.2d 1237, 1243, fn. 2, 197 USPQ 464, 469 (CCPA 1978); *Deere v. Heston*, 196 USPQ 238, 246 (D. Utah 1977); *Palmer v. Orthokinetics*, 197 USPQ 207, 208 (C.D. Calif. 1977); *Duplan v. Deering Milliken*, 444 F.Supp. 648, 751, 197 USPQ 342, 398 (D.S.C. 1977); *Lawrence v. Gillette*, 196 USPQ 610, 612 (C.D. Calif. 1977).

B. There Is No Conflict in the Circuits.

Penn International Industries, Inc. v. Pennington Corp., 583 F.2d 1078, 1081, 200 USPQ 651, 654 (9th Cir. 1978), partially quoted at page 6 of the Petition, is in accord. The Court there said, at page 1081:

To withstand challenge a combination patent must be synergistic; it must result "in an effect greater than the sum of the several effects taken separately." *Anderson's-Black Rock v. Pavement Co.*, 396 U.S. 57, 61, 163 USPQ 673, 674-675 (1969). See also *Sakraida*, 425 U.S. at 282. *Phrased differently, to be valid a combination patent must produce an "unusual or surprising result."* *Kamie-Autokomfort v. Eurasian Automotive Products*, 553 F.2d 603, 608, 194 USPQ 362, 366-367 (9th Cir. 1977); *Austin v. Marco Dental Products*, 560 F.2d at 972, 195 USPQ at 533-534. (Italics added).

Also in accord is *American Seating Co. v. National Seating*, 586 F.2d 611, 621, 199 USPQ 257, 264 (6th Cir. 1978), *cert. denied*, 202 USPQ 320 (1979), cited at page 6 of the Petition, where the Court said, at page 621:

The synergistic test is met when a combination of elements produces an effect which is "greater than the sum of the several effects taken separately." *Anderson's-Black Rock*, *supra*, 396 U.S. at 61, 90 S.Ct. at 308, 163 USPQ at 674-675 . . . *Stated another way, there must be some "unusual or surprising result" from a combination of old elements.* (Italics added).

Clark Equipment Co. v. Keller, 570 F.2d 778, 789, 197 USPQ 209, 217 (8th Cir. 1978), *cert. denied*,

200 USPQ 64 (1978), partially quoted at page 7 of the Petition, is another case in which the Court equated lack of synergism with the negative rule in *A.&P.*

In *Republic Industries v. Schlage*, 592 F.2d 963, 972, 200 USPQ 769, 779 (7th Cir. 1979), however, the Court said, at page 972:

. . . this court never intended that synergism be applied literally or that synergism is the sine qua non of patentability. Rather, the concept was employed only as a figure of speech to express the truism that when all the parts of a claimed invention are known, the combination (and the act of combining) is likely to be more obvious to one reasonably skilled in the art.²⁵ See *Reeves Instrument Corp. v. Beckman Instruments, Inc.*, 444 F.2d 263, 271, 170 USPQ 74, 80-81 (9th Cir.), *cert. denied*, 404 U.S. 951, 171 USPQ 641 (1971). However, because synergism has prevented the development of a consistent predictable body of law under section 103, and because the concept does not bear any logical ipso facto relationship to obviousness, the term has little, if any, utility. Therefore until Congress shall otherwise legislate or the the Supreme Court shall otherwise specifically hold, this court will continue to apply the *Graham* analysis as the exclusive means by which to measure nonobviousness under section 103.

²⁵The Supreme Court has expressed this idea in similar terms: "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding [a patentable] invention in an assembly of old elements. * * *" *Great A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 305-306 (1950). Accord, *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 281, 189 USPQ 449, 452 (1976).

But the Court did not deny the negative rule, set forth in *A.&P.*, and codified in Section 103. *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 466 (1966).

In any event, all of the Courts of Appeals agree that synergism is not a "fourth" factual test, as alleged in the Petition, at pages 4 and 6.

III.

Conclusion.

The experienced District Court, and the Court of Appeals, correctly held the Looker patent invalid, by applying the Section 103 test, as explained in *Graham*, and properly considered the failure of the old combination to provide any unusual or surprising consequences, as required by the *A.&P.* case, and codified in Section 103.

Neither the District Court, nor the Court of Appeals, held, or suggested, that synergism was a "fourth" factual test.

In all respects, then, the Court of Appeals for the Ninth Circuit is in accord with the decisions of this Court and the other Courts of Appeals cited by Petitioner.

So, the Petition should be denied.

Dated: August 9, 1979.

Respectfully submitted,

ROBERT D. HORNBAKER,
A Member of
FREILICH, HORNBAKER, WASSERMAN,
ROSEN AND FERNANDEZ,
A Professional Corporation,

Attorneys for Respondents.